

P23563.A03



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Shuichi TAKEUCHI et al.

Group Art Unit: 2872

Appln. No. : 10/623,692

Examiner: James PHAN

Filed : July 22, 2003

For : SCANNING OPTICAL SYSTEM

**RESPONSE TO RESTRICTION AND ELECTION REQUIREMENTS
WITH TRAVERSE**

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Amendment
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

In response to the Examiner's restriction requirement dated February 24, 2005, setting a one month period for response extending until March 24, 2005, and having been extended by three months to expire on June 24, 2005, by the accompanying Request for Extension of Time, Applicants elect, with traverse, the invention identified by the Examiner as Group I. Claims 1-11 are considered to be "readable" on the invention of Group I (as set forth by the Examiner).

Applicants further elect the species identified by the Examiner as Species 1 (wherein said beam reflected by said at least one lens surface proceeds above a top surface of said polygonal mirror) with traverse for the reasons expressed below. Claims 1-10 and 12-17 are considered to be "readable" on the Species 1, and at least claims 1-9 and 12-17 are considered to be generic by the Applicants (with regard to the species identified by the Examiner).

Applicants respectfully traverse the Examiner's restriction and election requirements.

In regard to the Election Requirement, Applicants initially note the improper manner in which the Examiner has identified the species (i.e., by the recitation of claim language rather than by identifying mutually exclusive disclosed embodiments or features). Applicants further submit that the search for the species identified by the Examiner would be coextensive or at least significantly overlap. That is, if the Examiner were to perform a search for the embodiment of Species 1 (i.e., (1) a scanning optical system as recited in claim 1, further including the subject matter of claim 10 (wherein said beam reflected by said at least one lens surface proceeds above a top surface of said polygonal mirror)), there would not appear to be a serious burden in continuing the examination of Species 2 (i.e., (2) a scanning optical system as recited in claim 1, further including the subject matter of claim 11 (wherein said beam reflected by said at least one lens surface proceeds below a bottom surface of said polygonal mirror)), especially since all of the claims are directed to a scanning

P23563.A03

optical system which includes all of the features recited in claim 1. Because the search of all of the species would be coextensive, it would not be a serious burden on the Examiner to examine all of the claims in this application. For this reason, and consistent with office policy as set forth in M.P.E.P. § 803, Applicants respectfully request that the Examiner reconsider and withdraw the Election Requirement.

For the foregoing reasons, it is submitted that the Election Requirement in this application is improper and it is respectfully requested that it be reconsidered and withdrawn.

In regard to the restriction requirement, Applicants submit that the Examiner has not provided any justification for the restriction of claims 1-17 into Groups I, II and III (set forth by the Examiner). Instead, the Examiner has merely described the sole independent claim 1 as a linking claim, and apparently arbitrarily chosen different sets of dependent claims to classify into different groups and characterize as restrictable inventions. Although dependent claims by their very definition recite additional subject matter to that of the independent claim from which they depend, Applicants submit that such recitations in no way qualify such dependent claims as *distinct* for purposes of restriction practice. Applicants note that the USPTO encourages the use of dependent claims rather than the submission of a multitude of independent claims. However, such use of dependent claims does not remove the Examiner's burden of setting forth proper reasons for justifying a restriction requirement.

Applicants further submit that the Examiner has not even attempted to characterize the Groups I, II and III as properly restrictable groups/inventions. In this regard, Applicants submit that the Examiner is required to set forth proper grounds for restriction as outlined in MPEP 806.05. In particular, the Examiner is required to provide a reasoned explanation as to how the different groups/inventions are *distinct* by explaining how the different groups/inventions are related by the restriction categories set forth in MPEP 806.05(a) through 806.05(i). Since there is no such explanation provided in the restriction requirement, Applicants submit that the Examiner has clearly not carried his burden. Applicants further note that it is clear that the Groups I, II and III can not be properly restricted since their respective relationships do not fall into any of the categories set forth in MPEP 806.05(a) through 806.05(i), and are rather merely dependent claims from the sole independent claim 1.

Additionally, even if the Examiner's characterization of Groups I, II and III as defining properly restrictable groups/inventions were to be considered correct (which is clearly not the case), Applicants respectfully request that all of the inventions defined in claims 1-17, nevertheless, be examined in the instant application, pursuant to the guidelines set forth in M.P.E.P. §803. That is, the Examiner is respectfully requested to reconsider the restriction requirement and find that there would not appear to be a "serious burden" on the Patent and Trademark Office in examining claims directed to the non-elected inventions

P23563.A03

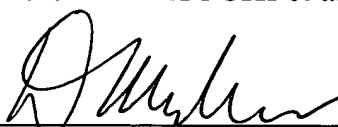
since the Examiner will have to search for a scanning optical system which includes all of the features recited in claim 1, from which claims 2-17 all depend.

Further, it would appear that the search for the inventions identified by the Examiner would be coextensive or at least significantly overlap. That is, if the Examiner were to perform a search for the invention of Group I, there would not appear to be a serious burden in continuing the examination of the other inventions of Groups II and III. For this reason, and consistent with office policy as set forth in M.P.E.P. 803, Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement.

For the foregoing reasons, it is submitted that the restriction requirement in this application is improper and it is respectfully requested that it be reconsidered and withdrawn.

Should there be any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Shuichi TAKEUCHI et al.


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June 24, 2005
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